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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,543	11/09/2001	Rudolf Pfaendner	PP/1-21105/A/CGM 474/PCT/	8274
324	7590	01/21/2004	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			WILSON, DONALD R	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/037,543

Applicant(s)

PFAENDNER ET AL.

Examiner

Donald R Wilson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 23 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - b) ☒ they raise the issue of new matter (see Note below);
 - c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

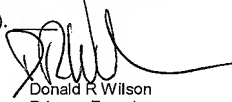
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1, 2, 9, 10 and 15.

Claim(s) withdrawn from consideration: 11-13.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____


Donald R Wilson
Primary Examiner
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ADDITIONAL COMMENTS

Response to Proposed Amendment After Final

1. Applicant's proposed amendment filed 12/23/03, after final rejection, has been fully considered with the following results.
2. The proposed amendment will not be entered because it raises new issues concerning the amendment to the specification inserting "ethylene/acrylic acid/acrylate" in place of "polyethylene/acrylic acid/acrylate" as a description of Lucalen® A 3110 MX of BASF. It is not seen that this is art recognized terminology as alleged, for what applicant has previously indicated was a terpolymer of ethylene, acrylic acid and butyl acrylate. Additionally, applicant has not as previously advised (Paper No. 8) "provided a basis for such an amendment showing that at the time the priority document was filed that the chemical composition of Lucalen® A 3110 MX of BASF was publicly known."
3. Applicant's arguments have overcome the objection to new matter and the corresponding rejection of claims under 35 U.S.C. § 112, first paragraph, concerning enablement for the compatibilizer polymer specifically containing solely ester groups which react with the sterically hindered phenol, and the objection and rejection are withdrawn.
4. If entered the amendment would have overcome the rejection of claims under 35 U.S.C. § 112, second paragraph and the rejection would have been withdrawn except in regards to the last line of Claim 10. As previously pointed out, "an acrylate" would need to have been substituted for "acrylates". "Acrylate" is not a specific monomer.
5. Applicant's arguments traversing the rejection of Claims 1,2,9,10 and 15 under 35 U.S.C. 103(a) as obvious over JP'054 in view of Examiner's Notice of Admissions by Applicant are not deemed to be persuasive, largely for reasons of record. Clearly the teachings of JP'054 are not limited to the working examples of the stabilizer and polymer being stabilized, as is apparently being argued. In regards to the ratio of polymer and stabilizing function in JP'054 versus the instant invention, applicant is relying upon limitations which are not in the claims.

It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Claims may be interpreted in the light of the specification for the purpose of defining a given term under

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35 USC 112 but it must be remembered that during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 13 USPQ 1320. Generally, one does not read into claims in pending applications limitations from the specification. *In re Winkhaus*, 188 USPQ 129; *In re Praeter*, 162 USPQ 541.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 571-272-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 571-273-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

Donald R Wilson
Primary Examiner
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